

Response to Applicant's Remarks

Applicant's response on 4/2/10 filed in response to the Office Action dated 11/2/09 has been received and duly noted.

Interview Summary

Several attempts were made to expedite the prosecution of this application. Examiner directly spoke to Attorney Robert H. Walat on 6/2/10 and he differed to other attorneys of record who work closely with the instant invention. Attny Walat said that the other attorneys of record would contact Examiner the following week. A reply was never received. Examiner contacted another attorney of record on 6/14/10, Timothy J. Oyer and he communicated to Examiner that he needed consult with client. A final message was left with Timothy J. Oyer on 6/17/10. A reply was never received as of 6/17/10.

In view of this response, the status of the rejections/objections of record is as follows:

Status of the Claims

Claims 1-3, 8, 9 and 26-30 are pending and allowed.

Claims 4-7, 10-25, 31 and 32 have been cancelled.

Claim 33 is currently pending and rejected.

In the previous office action, Examiner withdrew compound claim 33 from examination as being directed towards a previously cancelled claimed. The instant

invention, filed as a request for continued examination, was examined solely based upon a process (see amended claim set dated 12/15/05).

Additionally, in previous prosecution, the compound of claim 33 along with claims 31 and 32, was rejected and rejection was overcome due to Applicant cancelling the claim (see Non-Final Office Action dated 1/29/09). Also, the initial examined claims were drawn only to a process – no compounds claims were present – see claim set dated 3/15/05.

In an attempt to get Applicant to cancel compound claim 33, Examiner has provided an anticipatory prior art reference – see below.

Withdrawn Rejection

Claim Rejections - 35 USC § 103

The 103(a) rejection of claims 1-3, 7-9 and 26-30 regarding obviousness over Leguzza et al (EP 0207696 A1) in view of Solomons et al (Organic Chemistry, 9th Edition, 2008) has been withdrawn.

The withdrawal of this rejection is based upon Applicant's arguments and a document that Examiner has provided to support the claimed invention - DeKimpe et al The Chemistry of alpha-haloketones, alpha-haloaldehydes and alpha-haloimines 1988, John Wiley & Sons (see page 36, first complete paragraph and page 37, first complete paragraph). DeKimpe et al states that iodoketones are not widely used in synthesis due to their relatively instability.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

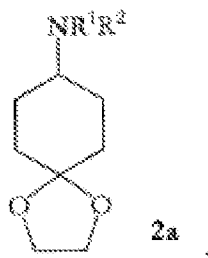
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 33 is rejected under 35 U.S.C. 102(b) as being anticipated by Avenell et al (Bioorg Med Chem Lett 1999, 2715-2720).

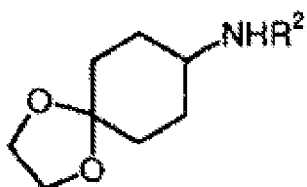
In claim 33, Applicant claims the following compound:

33. (Previously Presented) A 4-amino-cyclohexanone-ethyleneketal having the structure:



wherein one of R¹ and R² is hydrogen and the other of R¹ and R² is *n*-propyl.

Avenell et al discloses the compound as claimed - see compound 10 below and Scheme 1 of page 2717.



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R² = Me, Pr

This is a continuation of the same application (request for continued examination). All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Conclusion

Applicant is respectfully reminded that it is required that all claims be amended to elected group. Examiner also warns Applicant not to introduce new matter when amending.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Mabry, PhD whose telephone number is (571) 270-1967. The examiner can normally be reached on M-F from 9am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's primary examiner can be reached at (571) 272-0684, first, or the Examiner's supervisor, Janet Andres, PhD, can be reached at (571) 272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

/John Mabry/
Examiner
Art Unit 1625

/Rita J. Desai/

Primary Examiner, Art Unit 1625